

REMARKS/ARGUMENTS

In the September 24, 2003 Office Action, the Examiner asserted that the Declaration filed on June 20, 2003 had been considered but was ineffective. The Examiner asserted that the Applicant must provide a Declaration establishing possession of the whole invention claimed or something falling within the claim and that the information and Declaration provided did not disclose the specific features of the service. Moreover, the Examiner required Declarations of the testimonial evidence provided in the various exhibits attached to that Declaration

In Response, Applicant submits herewith a Supplemental Declaration of Prior Invention in the United States to Overcome Cited Publication by the inventor, Peter Wolf. This Declaration specifically outlines the differences between the invention and that of "traditional" event photography methods. The Declaration also establishes that the claimed invention was commercially established in May of 1999. The inventor took pictures for a local bicycle club at a bike ride and associated identifying data with each picture taken. The identifying data included the month, day, and time the picture was taken. The event participants were informed of the system and could find their pictures according to the time the picture was taken at the web-site. In September of 1999 the Lighthouse Century race was photographed and the photographs provided on the web-site in accordance with the present invention.

Applicant also provides the Declaration of Bruce G. Collier, President of the San Luis Obispo Club, and who was in charge of the Lighthouse Century event in 1999. Mr. Collier declares that he was contacted by the inventor, Peter Wolf, in the summer of 1999 and that the invention was explained to him. He declares that he had never heard of such a system used with event photography and thought that the idea was unique. He

further declares that the Lighthouse Century organizers continue to provide the services of the inventor each year.

The establishment of the invention is further supported by the Declaration of Andy Parkinson who in July of 1999 updated the inventor's web-site to include a shopping cart order sub-system so that the event participants could order on-line using credit card payment or the like. Mr. Parkinson declares that the web-site was already up and running at the time and included pictures taken at different events which could be searched by bib number or the time it was taken.

In light of these Declarations, Applicant submits that the invention was not only conceived or reduced to practice, but also commercially established well before the October of 1999 www.runnersworld.com publication reference cited by the Examiner.

In the above-identified Office Action, the Examiner requested information with respect to Marathon Foto. Applicant does not have any documents describing the services of Marathon Foto, but the inventor in his Declaration describes the methodology of Marathon Foto at the time of the invention. This "traditional" methodology required essentially twelve steps, as described in Paragraph 3 of Peter Wolf's Declaration, which were very time consuming and expensive. In contrast, the present invention requires only six steps, two of which are conducted by the event participant by finding the image of interest on the web-site and ordering the image. In contrast to the "traditional" event photography methodology, the present invention is able to provide photographs to every single participant of the event, photograph even small events which would otherwise be unprofitable for the "traditional" methodology, requires much less time and is much less expensive.

Claims 1, 3, 4, 16 and 18-20 were again rejected under 35 U.S.C. §103(a) as being unpatentable over the public use of the service provided by Marathon Foto, as evidenced by the runnersworld web-site dated October 6,

1999, in view of an official notice regarding competitive sporting events and further in view of Garfinkle.

As stated in the inventor's Peter H. Wolf, Declaration, the present invention was conceived of and reduced to practice months before the www.runnsworld.com publication "predicting" that Marathon Foto would have proofs available on-line in the future. In fact, in May of 1999 the present invention was commercially implemented and used. This was at least five months before the cited publication date of October of 1999.

Peter Wolf's Declaration also describes the time consuming, expensive and error prone task of the traditional method of event photography, which Marathon Foto used, and the many problems associated therewith. As stated in Mr. Wolf's Declaration, prior "traditional" methods consisted essentially of twelve steps whereas the present invention requires only six steps. Whereas the traditional event photography method used by Marathon Foto resulted in some event participants not receiving photograph order forms due to human error or the inability to see the event participant's bib number, using the present invention all photographs are viewable. This is due to the fact that the present invention is not restricted to bib numbers, but rather the person seeking the photo can use the time or estimated time the photograph was taken to search for the photo as well.

Thus, the present invention overcomes many of the disadvantages and problems encountered with "traditional" event photography which Marathon Foto used at the time of the invention.

The time period when the present invention was commercially implemented is supported by the Declaration of Andy Parkinson as well as the Declaration of Bruce G. Collier. During the summer of 1999, Mr. Collier was President of the San Luis Obispo Bicycle Club and indicates that he was contacted by the inventor, Peter Wolf, requesting approval to photograph riders of the September, 1999 Lighthouse Century event. Mr. Collier indicated that after having the invention explained to him by Mr. Wolf, that he

"had never heard of this with the event photography and thought the idea was unique". Mr. Collier has indicated that the unique service of the present invention has been continued to be offered to their participants on both of the Century rides each year.

Peter Wolf indicates in his Declaration, that when he first introduced the invention in 1999, there was great uncertainty if customers would be willing to search for their own pictures. He declares that many individuals suggested that the present invention's approach would fail as event participants were not used to searching for their own pictures, but were instead accustomed to receiving thumbnail proofs in the mail. Thus, at the time of the introduction of the invention there was great uncertainty as to the successfulness of the business model.

Notwithstanding the skepticism, the number of orders and revenues received under the present invention quadrupled in the first three months that the present invention was offered. Since then, Mr. Wolf declares that he has received between 2000 and 4000 orders per year. At first, it appeared as if all event organizers were interested in the invention, with many event organizers complaining about the traditional methodology. However, it was not long until competitors began to copy Applicant's invention and take business away from him.

The Federal Circuit has identified a number of factors that indicates non-obviousness, including "copying, long felt but unsolved need, failure of others, commercial success, unexpected results created by the claimed invention, . . . and skepticism of skilled artisans before the invention." In re Rouffet, 149 F.3d 1350,1355 (Fed. Cir. 1998). The present invention falls within many of these factors, including long felt but unsolved need, skepticism of skilled artisans before the invention, commercial success, and copying. Thus, Applicant respectfully asserts that the Marathon Foto "traditional" methodology fails to serve as a basis of obviousness of the present invention.

Each of the independent claims (1, 51, 59 and 64) recite that identifying data is associated with each photograph taken, the photographs are cataloged in a web-site server according to the identifying data, and the particular photograph can be accessed and searched for on the server utilizing the identifying data. Claim 3 recites the step of posting the identifying data associated with each photograph so that it is made available to the participants of the event for later use in searching the server. Claim 4 recites that the identifying data include a number corresponding to a number worn by an event participant. Claim 16 recites the identifying data comprises a name of an event participant. These claims were rejected under the www.runnersworld.com publication, dated October 6, 1999 in view of an "official notice" regarding competitive sporting events, and further in view of Garfinkle.

The official notice with respect to these claims is that it "is notoriously known in the art of administering running and sporting events the participants are given bib numbers for registration and identification purposes. This identification data is typically associated not only with the participant's performance, i.e. their finishing time, but also their name and contact information so that they can be informed of the results." It was further asserted in the Office Action that "it would have been obvious to one skilled in the art at the time that instead of obtaining a participant's information on an individual basis, the service instead approaches the race organizers and obtains the full list of participants, their bib numbers, their finishing times, and contact information all at once in order to expedite the process reduced to reading the proofs of the photographs". In fact, as stated in Mr. Wolf's Declaration, this formed part of the process of the "traditional" event photograph methodology. The photographers before the present invention would need to visually scan all thumbnail prints or negatives of all photographic images taken, cross-reference these numbers with the roster provided by the event organizers, and then mail the thumbnail proofs to the

event participant. Problems arose where bib numbers were not easily viewed. Human error also could result in an event participant receiving the thumbnail proofs of another event participant. There was also the problem of the long delay (weeks or months) before the event participant received his or her thumbnail proofs, if any at all. Mr. Wolf indicates in his Declaration that the process is very time consuming and expensive. Mr. Wolf also declares that the bib numbers were only used for cross-referencing purposes, and that the order forms and cards being sent to the event participants never identified the event participant by bib number, but rather by name and address according to the cross-referenced roster.

Mr. Wolf declared, in paragraph 19 of his Declaration, that he has never heard of an event organizer informing participants of their results by mailing something to the address of the participant after the event. Instead, event participants of a competitive and timed event such as a marathon or triathlon are informed of their results by viewing a "results board" after the race. Pull tags and timing devices are used to establish the finish time of a participant. Alternatively, race chips can be used. Unfortunately, both of these methods are prone to human and electronic error. In fact, Mr. Wolf declared that in some of the events he has photographed, the event organizers have actually referred to his photographs to determine and resolve conflicting issues of finish times.

The Office Action properly admitted that the Marathon Foto/Official Notice does not provide that the photography service catalogs the proofs and photographs on the server makes the proofs accessible to race participants via the Internet. Thus, the Office Action combined Garfinkle, which teaches a method of providing photographs on a web-site for viewing and purchasing.

However, as discussed in paragraph 22 of Mr. Wolf's Declaration, the methodology disclosed by Garfinkle could not be implemented in such event photography, particularly large competitive racing events such as marathons, triathlons, etc. This is due to the fact that Garfinkle discloses digitizing

pictures on a roll or batches of rolls of film which are then saved on an accessible server with a password or other access code. That is, the entire roll or batch of photographs are under the same code. This would require the review of hundreds or perhaps thousands of thumbnail images by an event participant to find his or her image. Mr. Wolf pointed to the example that, in 2002, Marathon Foto took over 125,000 photographs of more than 31,000 finishers. Even if the photos were displayed on-line, as taught by Garfinkle, the event participants of the marathon would have to sort through literally thousands of thumbnail images in an attempt to find their own photograph. Garfinkle et al. makes no mention of cataloging images according to identifying data for each image, and Mr. Wolf declared that no other commercial endeavor suggested cataloging images for event photography purposes prior to his invention.

Thus, the combination of the www.runnersworld.com web-site, dated October 6, 1999 as well as the LaSalle Bank Chicago Marathon web-site, in view of official notices, and further in view of Garfinkle et al. fail to disclose the present invention and render it obvious.

To establish a *prima facie* obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 In re Vaeck, 20 JUSPQ 2d 1438 (Fed.Cir. 1991). Applicant fails to see the suggestion or motivation to combine the references proposed by the Examiner, without using Applicant's disclosure and improper hindsight. "The genius of invention is often a combination of known elements which in

hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some 'teaching, suggestion or reason' to combine cited references." McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351 (Fed.Cir. 2001) (quoting Gambro, 110 F.3d at 1579). Thus, "a showing of a suggestion, teaching, or motivation to combine the prior art references is an essential evidentiary component of an obviousness holding." Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, (Fed.Cir. 2000) (emphasis added, quotation omitted). Moreover, the need for a careful showing of a teaching to combine or modify references is particularly critical in cases involving less complex technologies, where the temptation to improperly denigrate an invention is greatest. In re Dembiczak, 175 F.3d 994, 999 (Fed.Cir. 1999).

In addition to a failure within the references themselves to suggest or motivate the combination thereof, the combined references also fail to teach all the claim limitations. With respect to claims 1, 3, 4, and 16, the combined references fail to disclose associating identifying data with each photograph taken, which can include a number corresponding to a number worn by an event participant or the name of the event participant; informing event participants of the identifying data; cataloging the photographs on a web-site server according to the identifying data; and accessing the server and searching for a particular photograph using the identifying data. To modify the Marathon Foto "traditional" methodology in view of Garfinkle would render an unusable system in which an event participant would literally need to view hundreds or thousands of thumbnail images before finding his or her image for ordering. Modifying Marathon Foto to arrive at the present invention can only be accomplished through improper hindsight using Applicant's own disclosure as a basis for such modification.

Moreover, these cited references fail to recognize the many disadvantages and problems encountered with "traditional" event photography methodology. These problems, disadvantages, and the manner

in which the present invention overcomes these problems is detailed in the Specification and in Mr. Wolf's Declaration. In the rare case where the prior art does not appreciate the existence of the problem solved by the invention, the applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention. In re Nomiya et al., 184 USPQ 607, 612-613 (CCPA 1975).

Claims 5-9, 17, 60- 64-68 and 72-75 were rejected as being obvious in light of the prior combination in view of to Sigel et al. (U.S. Patent No. 6,545,705). It was properly admitted in the Office Action that the combination, minus Sigel, specifically failed to disclose "a component worn by an event participant; or triggering a camera when the component passes a predetermined point which may include a sensor interfacing with a component".

Sigel et al. teaches a method of using a line scan digital camera in conjunction with a microprocessor controlled timing and analysis circuit to determine precise finish line analysis. As stated in the Office Action, when the image changes substantially, i.e. a person passes in front of the camera's field of view, a static image of that instance is captured and stored externally. Relevant image analysis is triggered by the initial appearance of a hand, arm, or leg in the field of view of the camera. As stated by Mr. Wolf in his Declaration, such line scan cameras allow for precise finish line analysis, such as photo finishes at horse races or the like. Such line scan digital cameras are highly specialized and not used for purposes of the present invention. Claims 5-9, 17, 60- 64-68, and 72-75 are related to recitations where the identifying data is acquired from a code from a component worn by an event participant, which may be a passive component, a bar code, an inductive circuit, an active component or the like which interfaces with a sensor. The component can also be used to trigger a camera to take a photograph when a component passes a predetermined point. However, the camera is of a normal type and the photograph is of an entire event

participant, not a leg, hand, etc. which crosses a finish line, which would not be desirable to purchase and keep as a memento of the event.

Accordingly, Applicant submits that Sigel et al. fails to overcome the shortcomings of the www.runnersworld.com publication, public use of the service provided by Marathon Foto, "official notices", and Garfinkle. Moreover, Sigel et al. fails to disclose a system which would be operable and commercially viable in event photography as used for momentos and the like. As such, Applicant respectfully submits that this combination does not render claims 5-9, 17, 60- 64-68, and 72-75 obvious. Once again, this combination fails to appreciate the existence of the problems solved by the present invention, which in itself is strong evidence of the non-obviousness of the invention.

Claims 10-12 and 69-71 were rejected as being obvious over the public use of the service provided by Marathon Foto - as evidenced by the www.runnersworld.com publication, as well as the LaSalle Bank Chicago Marathon web-site, in view of official notices regarding the competitive sporting events, in further view of Garfinkle et al., in further view of Sigel et al., and further in view of Hermanns et al.

Hermanns et al. (U.S. Patent No. 4,274,076) simply teaches a chip-like system where its participants wear active transmitters that trigger sensors located at the finish line for determining accurate finishing time of each participant. Mr. Wolf indicates that these systems were in place before his invention, but had no bearing whatsoever to event photography as the photograph was not cataloged or otherwise linked to these finishing times nor the photographs triggered by these chip-like systems.

Thus, Hermanns et al. fails to overcome the shortcomings of the previously discussed references, fails to address the problems and disadvantages of "traditional" event photography methodology, and fails to disclose all of the claim limitations of the cited claims 10-12 and 69-71. Applicant submits that the present invention can only be rendered obvious by

these combined references if improper hindsight, using Applicant's own disclosure, is used.

Claims 13-15 and 51-54 were rejected as being obvious in view of the public use of the service provided by Marathon Foto, as evidenced by the www.runnersworld.com publication dated October 6, 1999 as well as the LaSalle Bank Chicago Marathon web-site in view of various official notices regarding competitive sporting events, and further in view of Garfinkle et al., in further view of Sigel et al., and further in view of Gluck (U.S. Patent No. 6,532,345).

Claims 13 and 51 recite that the identifying data comprises the date and time the photograph was taken. Claims 14 and 53 recite that an approximate time can be used to search for a particular photograph. Claims 15 and 54 provide a formula for calculating approximate time. The Office Action properly admitted that the system of Marathon Foto/Official Notice/Garfinkle/Sigel does not explicitly provide these recitations.

Gluck discloses an imaging system and method directed to the photographing of event spectators, not participants, seated in a stadium or waiting in line at a particular location within the stadium. The bulk of the patent is directed to photographing each spectator as he or she is in his or her seat, which has been pre-plotted. The spectator is photographed and then the spectator is subsequently approached by a vendor attempting to sell the spectator a photograph or novelty item bearing the photograph. Alternatively, the spectator is photographed while waiting in a line. Gluck discloses that such photographs can be cataloged according to the physical location of the line, a number displayed at the line, or a time when the picture was taken.

The combination of Marathon Foto, Garfinkle, Sigel, and Gluck is improper as the references fail to provide the suggestion and motivation for combination. The mere fact that the references can be combined or modified does not render the results in combination obvious, unless the prior art also

suggest the desirability of the combination. MPEP §2143.01 citing, In re Mills, 16 USPQ 2d 1430 (Fed.Cir. 1990). Moreover, the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified. As stated in MPEP §2143.01, in such instance there is no suggestion or motivation to make the proposed modification and the teachings of the references are not sufficient to render the claims *prima facie* obvious. Of course, as discussed in the MPEP, using Applicant's disclosure arises to impermissible hindsight reconstruction.

Moreover, Gluck requires that the spectators purchase their photographs or novelty items at the event. The location of the spectator must be ascertainable, even if the spectator is waiting in a line as there are many lines within a stadium or other such similar venue.

Furthermore, the present invention is directed to taking photographs of event participants, not event spectators. Claims 51 and 52 have been amended to particularly recite that competitors of the sporting event are photographed and identifying data is associated with each photograph of the sporting event competitor for later cataloging and searching. Gluck in no way discloses, teaches, or even infers of taking photographs of the event participant competitors. In fact, the system and method disclosed by Gluck would not be able to be used in running races such as marathon and triathlons, bike races, etc., as described in Mr. Wolf's Declaration. These event participant competitors then view and order the photographs after the event. Gluck simply does not disclose this and would not be able to accommodate these sporting events.

The Office Action properly admitted that the combination of Marathon Foto/Garfinkle/Sigel/Gluck does not explicitly provide that the approximate time be used to search for the photograph, or that the approximate time be a function of the total distance/time ran by the event participant and the distance of the photographer from the starting point. The Examiner put

forward another "official notice" stating that participants approximate time at a certain point in the race could be calculated according to their "split times". However, Mr. Wolf in his Declaration (paragraph 20) disputes this. Although runners can calculate their split times for training and timing purposes, event photographers have not organized their photos by bib numbers or calculated time prior to the present invention. Searching for event participant's images on a web-site according to time or estimated time that the photograph was taken was absolutely novel at the time of the invention. Thus, the only way to arrive at the recitations in claims 14, 15 and 53 and 54 would be to use Applicant's own disclosure and improper hindsight. Of course, this is not allowed.

As the references should not be combined and fail to teach all of the claim limitations of claims 13-15, and 51-54, Applicant respectfully submits that these claims are patentably distinct and not rendered obvious by this combination.

CONCLUSION

From the foregoing amendments and remarks, Applicant respectfully submits that the currently pending claims, as amended, are not rendered obvious in light of the above-mentioned combination of references and "official notices". Accordingly, the application is in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Aaron T. Borrowman', is written over a horizontal line. A checkmark is drawn to the right of the signature.

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